

REMARKS

Summary of the Final Office Action

Claims 1-5, 18 and 19 stand rejected under 35 U.S.C. § 101 because the claims are allegedly “non-statutory descriptive material recorded on recording medium.”

Claims 6-17 and 20-23 are allowed.

Summary of the Response to the Office Action

Applicant has amended independent claim 1 so that the claims now differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. Accordingly, claims 1-23 remain currently pending for consideration.

Rejection under 35 U.S.C. § 101 and Statement of Summary of Examiner Interviews

Claims 1-5, 18 and 19 stand rejected under 35 U.S.C. § 101 because the claims are allegedly “non-statutory descriptive material recorded on recording medium.” Examiner Onuaku is thanked for the courtesies extended to Applicants’ undersigned representative in a telephone interview conducted on July 27, 2006 with regard to this rejection. During this interview, Applicants’ undersigned representative traversed the rejection under 35 U.S.C. § 101 explaining that the rejected claims in their current form appear to comply the directives of well-established U.S. case law, such as In re Lowry, 32 F. 3d 1579 (Fed. Cir. 1994) which is quoted in MPEP § 2106.IV.B.1.

The Examiner responded by explaining that the USPTO has recently changed it’s position with regard to the patentability of “record medium” claims under 35 U.S.C. § 101 in

accordance with the guidelines set forth in the Official Gazette notice dated November 22, 2005 entitled "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility." Accordingly, the Examiner noted that a USPTO examining panel had deemed that the claims were properly rejected under 35 U.S.C. § 101 in light of these interim guidelines.

Applicants' undersigned representative pointed out that the only specific reference in the November 2005 Interim Guidelines with regard to medium claims appears to be in ANNEX IV of this document. This portion of the November 2005 Interim Guidelines appears to be merely a repeat of existing portions of MPEP § 2106 with regard to medium claims in that it also cites many of the same cases, including a citation of In re Lowry for the same proposition as set forth above regarding the statutory nature of data structures that increase computer efficiency being stored on a computer readable medium. See, for example, the second paragraph of ANNEX IV of the November 2005 Interim Guidelines. In response to the assertions made by Applicants' undersigned representative in this regard, Examiner Onuaku noted nevertheless that the examining panel had reached a conclusion that the claims were properly rejected. The Examiner mentioned that additional structure could possibly be added to the claim, such as a reproducing apparatus or a recording apparatus. Applicants' undersigned representative noted that claims to a record medium do not need to include such structure, as directed by well-established case law such as In re Lowry, discussed above.

Applicants' undersigned representative then inquired as to whether the Examiner would grant a personal interview to discuss ways to overcome the 35 U.S.C. § 101 rejection in more detail. The Examiner agreed that some senior USPTO Examiner would need to join in this interview in order to possibly obtain additional clarification on the outstanding issues.

Applicants' undersigned representative inquired whether a member of the above-mentioned examining panel could join the interview, but the Examiner noted that this would be unlikely. Instead, the Examiner recommended that his Supervisory Patent Examiner ("SPE") James J. Groody take part in such a personal interview.

Accordingly, Applicants' undersigned representative placed a telephone call to SPE James J. Groody on August 23, 2006 in an attempt to schedule such an interview. During this telephone conversation with Examiner Groody on August 23, 2006, Applicants' undersigned representative explained how the only outstanding issue in this application is the rejection under 35 U.S.C. § 101. Applicants' undersigned representative explained how Applicants believe that the claims already fully comply with 35 U.S.C. § 101 in light of U.S. case law such as In re Lowry.

Applicants' undersigned representative went on to point out to Examiner Groody that Primary Examiner Thai Tran indicated in writing on an Interview Summary form dated December 8, 2005 in this application that it "appears there are functional descriptive materials present in the claims 1-5, 18 and 19" and that the rejections under 35 U.S.C. § 101 should thus be withdrawn.

Examiner Groody then recommended that instead of Applicants' undersigned representative conducting a personal interview at the USPTO on this issue, Examiner Groody would instead consult personally with a representative of the examining panel discussed previously. Examiner Groody also noted that he would consult with Primary Examiner Thai Tran, who had issued the above-discussed Interview Summary in this application.

Examiner Onuaku placed a telephone call to Applicants' undersigned representative on August 30, 2006 with the results of Examiner Groody's investigation. In particular, the USPTO suggested a minor revision to independent claim 1 that the USPTO had deemed would overcome the rejection under 35 U.S.C. § 101. Applicants proposed a minor revision to the USPTO's suggested language in a telephone call to Examiners Onuaku and Groody on September 1, 2006. The USPTO approved Applicants' revision to their originally suggested language on that same date. Accordingly, Examiner Onuaku thus informed Applicants' undersigned representative that if the preamble of independent claim 1 was amended to recite a "DVD information record medium having an audio zone and a video zone encoded with information, the information comprising:" then the outstanding rejections under 35 U.S.C. § 101 would be withdrawn and this case would pass to issuance.

Accordingly, Applicants have implemented this particular change to independent claim 1 in the instant Amendment. Withdrawal of the rejections under 35 U.S.C. § 101 is thus respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the entry of the Amendment to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. As no remaining issues are outstanding in this

application, all claims are now in condition for allowance and early issuance of a Notice of Allowability is respectfully requested.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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